IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.	10/015,816	**Group Art Unit:**	2173
Applicants:	Thomas J. SHAFRON, et al.	**Examiner:**	Michael Roswell
Filing Date:	November 1, 2001	**Docket No.**	085804.014301
Title: Method and System of Facilitating On-Line Shopping Using an Internet Browser		**Customer No.**	32361

Mail Stop Appeal Brief - Patents
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APPEAL BRIEF

Sir:

Pursuant to the Notice of Appeal filed in the above-identified application on February 8, 2007, and in accordance with 37 C.F.R. § 41.37, Appellants respectfully submit the following Appeal Brief.
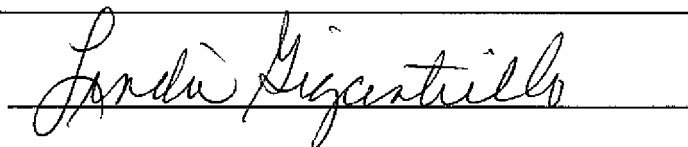
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A Notice of Panel Decision from Pre-Appeal Brief Review, mailed April 10, 2007, set a time period for filing an Appeal Brief to be one month from the mailing date of that decision. A Petition for Extension of Time under 37 C.F.R. § 1.136(a) is submitted herewith, extending the period specified in the Notice from May 10, 2007 to and including August 10, 2007. In view of the accompanying Petition, this Appeal Brief is believed to be timely filed.

The Commissioner is authorized to charge the amount of $ 500.00 to Deposit Account No. 50-1561 to cover the fee under 37 C.F.R. § 41.20(b)(2). Any deficiency in or overpayment of this fee should likewise be charged or credited to Deposit Account No. 50-1561.

The following items are presented under the headings listed, and in the order prescribed, in 37 C.F.R. § 41.37(c)(1).

37 C.F.R. § 41.37(c)(1)(i): REAL PARTY IN INTEREST

Yahoo! Inc., the assignee of the entire interest of the above-identified application (as evidenced by Assignment documents recorded on June 27, 2002, at Reel 013061, Frame 0045), is the real party in interest in this appeal.

37 C.F.R. § 41.37(c)(1)(ii): RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

37 C.F.R. § 41.37(c)(1)(iii): STATUS OF CLAIMS

Claims 1-24, 59 and 60 are pending in the application. In the final Office Action dated November 8, 2006, claims 1-24, 59 and 60 were rejected. Claims 1-24, 59 and 60 remain under final rejection and are the subject of this appeal.

The Notice of Panel Decision from Pre-Appeal Brief Review stated that the rejected claims were claims 1-23, 59 and 60, and made no mention of claim 24. It is respectfully submitted that claim 24 remains pending in the application, as evidenced by the discussion thereof in the final Office Action dated November 8, 2006.

37 C.F.R. § 41.37(c)(1)(iv): STATUS OF AMENDMENTS

No amendments have been filed subsequent to the final rejection dated November 8, 2006.

37 C.F.R. § 41.37(c)(1)(v): SUMMARY OF CLAIMED SUBJECT MATTER

Claims 1, 12, 18, 21 and 60 are independent. A concise explanation of the subject matter defined in each independent claim is given below. Page and line numbers in the specification are given herein as (pp.ll), where pp indicates the page number and ll indicates the line number.

1. Claim 1

Claim 1 is directed to method of facilitating on-line shopping by a shopper (10.11-10.12; 13.3-13.4; 49.5; 49.15-49.19) at a supported merchant web site (49.5; 54.17-55.4). The shopper has a computer with an Internet browser installed thereon (49.11-49.15). The method includes the following steps:

(a)   Computer code is communicated (for example, transmitted from a server to the shopper's computer) to add a shopping assistant button to a toolbar of the Internet browser (49.3-49.7; 52.3-52.5).

(b)   Determination computer code is communicated to the shopper's computer; this determination computer code is configured to determine if a merchant web site is a supported merchant web site (51.7-51.9; 54.10-54.15).

(c)   A wallet is created for the shopper in a database on a server (52.8-52.12). The wallet is secured by a first security key previously received from the shopper (53.10-53.12).

(d)   A second security key is received from the shopper (57.2-57.5).

(e)   The first security key and the second security key are compared (57.5-57.8).

(f)   If the first and second security keys are the same, the wallet is communicated to the shopper's computer (57.7-57.13).

2. Claim 12

Claim 12 is directed to an Internet browser interface, which is displayable by an Internet browser on a computer display (3.17-3.21; 6.2-6.6; 13.3-13.5). This interface includes a toolbar (17.15-17.22) and a shopping assistant button in the toolbar (49.3-49.5). The shopping assistant button is defined by computer code received from a content provider (49.5-49.10). This code is operable with a processor of the computer (51.7-51.9) in order to:

(a) intercept an Internet address for each Internet site to which the Internet browser is caused to navigate (51.11-51.13);

(b) determine if a web site to which the Internet browser is caused to navigate is a supported merchant web site (51.13-51.17; 54.11-54.15); and

(c) if the web site is a supported merchant web site, automatically fill out a check-out web page of the supported merchant web site (57.14-57.19) using a wallet (57.17-57.20) and a supported merchant rules and mapping file (58.9-58.11).

3. Claim 18

Claim 18 is directed to a system for facilitating on-line shopping (10.11-10.13) by a shopper having a computer with an Internet browser (49.3-49.5). This system includes a server (49.5-49.7; 50.6-50-10) having a data storage device with a database thereon (52.11-52.12). The system also has a processor operable with software (50.6-50.10) for:

(a) communicating shopping assistant computer code to add a shopping assistant button to a toolbar of the Internet browser (49.3- 49.7; 52.3-52.5); the shopping assistant computer code is operable to determine if a web site to which the Internet browser is caused to navigate is a supported merchant web site (51.7-51.9; 54.10-54.15);

(b) receiving wallet data including a first security key from the shopper and creating a wallet for the shopper in the database (52.8-52.14), the wallet being secured by the first security key (53.10-53.12);

(c) receiving a second security key from the shopper (57.2-57.5);

(d) comparing the first security key and the second security key (57.5-57.8); and

(e) if the first and second security keys are the same, communicating the wallet to the shopper's computer (57.7-57.13).

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4. Claim 21

Claim 21 is directed to a method of facilitating on-line shopping by a shopper at a supported merchant web site (49.5; 54.17-55.4). The shopper has a computer with an Internet browser installed thereon (49.11-49.15). The method includes communicating computer code to add a shopping assistant button to the Internet browser (49.3- 49.7; 52.3-52.5). This computer code intercepts an Internet address for each Internet site to which the Internet browser is caused to navigate (51.11-51.13), and determines at the computer if a web site to which the Internet browser is caused to navigate is a supported merchant web site (51.13-51.21; 54.11-54.15). If the web site is a supported merchant web site, the computer code automatically fills out a check-out web page of a supported merchant web site (57.14-57.19) using a wallet (57.17-57.20) and a supported merchant rules and mapping file (58.9-58.11).

5. Claim 60

Claim 60 is directed to a method of facilitating on-line shopping by a shopper (10.11-10.12; 13.3-13.4; 49.5; 49.15-49.19) at a supported merchant web site (49.5; 54.17-55.4). The shopper has a computer with an Internet browser installed thereon (49.11-49.15). The method includes the following steps:

(a)   Computer code is communicated (for example, transmitted from a server to the shopper's computer) to add a shopping assistant button to a toolbar of the Internet browser (49.3-49.7; 52.3-52.5).

(b)   A wallet is created for the shopper in a database on a server (52.8-52.12). The wallet is secured by a first security key previously received from the shopper (53.10-53.12).

(c)   A determination is made at the computer if a web site to which the Internet browser is caused to navigate is a supported merchant web site (51.13-51.21; 54.11-54.15). The shopping assistant button also provides an indicator when the Internet browser is caused to navigate to a supported merchant web site (56.11-56.13).

(d)   A second security key is received from the shopper (57.2-57.5).

(e)   The first security key and the second security key are compared (57.5-57.8).

(f)   If the first and second security keys are the same, the wallet is communicated to the shopper's computer (57.7-57.13).

37 C.F.R. § 41.37(c)(1)(vi): GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Claims 1-14, 16-21, 23, 24, 59 and 60 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over O'Leary et al. (U.S. Pat. Application Publication No. 2002/0077978) and further in view of Sidles (U.S. Pat. Application Publication No. 2002/0062342) and Wiens et al. (U.S. Pat. No. 5,808,894).

2. Claims 15 and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over O'Leary et al., Sidles and Wiens et al., and further in view of "Band Objects" (Microsoft).

37 C.F.R. § 41.37(c)(1)(vii): ARGUMENT

I. Introduction

    A. Grouping of Claims

The claims do not stand or fall together. Arguments are presented below for the separate patentability of the following groups of claims:

    1. Ground of rejection (1):

        a. Group (1): Claims 1-11, 18-20 and 59 (claims 1 and 18 independent).

        b. Group (2): Claims 12-14, 16-17, 21, 23 and 24 (claims 12 and 21 independent).

        c. Group (3): Claim 60 (independent)

    2. Ground of rejection (2):

        Claims 15 and 22.

B. References cited in the final rejection

1. O'Leary et al.

O'Leary et al. is understood to disclose a method and system for processing payments, in which a customer's payments are executed through a secure electronic file transfer (EFT) network (paragraph 27). A customer may set up an electronic wallet which is funded using on-line banking technology (paragraphs 138-140). A merchant may subscribe to the system by establishing a Virtual Private Lockbox (VPL) account at the bank (paragraph 61). Whether or not a merchant is a subscriber, a customer is able to push a credit to the merchant's bank account (paragraph 174).

2. Sidles

Sidles is understood to disclose a method and system for completing merchant-supplied forms in on-line purchase transactions (paragraph 17). This method and system incorporates a rule-based expert system, so that a user (customer) may fill out a merchant's form even if the merchant's site is completely new and unfamiliar to the customer (paragraph 35). A form is downloaded from a merchant web site by a form fill proxy and filled out using a form fill system (paragraph 55); these functions are performed by proxy servers and are network based. A dictionary database at the server level contains the rules that are used to guide the filling out of forms (paragraphs 61-62).

3. Wiens et al.

Wiens et al. et al is understood to disclose a method for enabling a personal computer to communicate with a centrally located vendor computer to which a customer may connect via a customary communication medium, such as a modem through telephone lines, etc. (column 4, lines 25-30). Computer code is provided to the user's computer to facilitate off-line order entry, so that a user may complete an automated order and only connect to the vendor's central computer to actually place the order after the order information has been entered off-line. This system allows users to compose their orders prior to calling the central computer, thus minimizing telephone expenses (column 3, lines 37-41). Wiens et al. thus is understood to

describe a dedicated customer order environment, wherein a user installs custom software to communicate with a predetermined vendor for placing orders in a manner that minimizes communication bandwidth through the use of pre-entered information being entered at the user's computer prior to establishing a communication session with a known vendor computer.

4. Band Objects (Microsoft)

This reference is understood to disclose a software application for creating and defining bands which may be displayed as a portion of a taskbar or a floating toolbar, or inside a browser window.

II. Arguments with respect to ground of rejection (1)

A. Group (1): Claims 1-11, 18-20 and 59

1. Limitations recited in the claims

a. Independent method claim 1 recites communicating determination computer code to the computer of the on-line shopper, the determination computer code configured to determine if a merchant web site is a supported merchant web site.

b. Independent system claim 18 recites a server comprising a processor operable with software for communicating shopping assistant computer code to add a shopping assistant button to a toolbar of an Internet browser, the shopping assistant computer code operable to determine if a web site to which the Internet browser is caused to navigate is a supported merchant web site.

c. Claims 2-11 and 59 depend either directly or indirectly from claim 1; claims 19 and 20 depend from claim 18. All of these claims therefore include the limitations noted above.

d. The phrase "a supported merchant web site" is used in the specification and claims to point to a distinct type of web site, differentiated from merchant web sites in general. A "supported merchant web site" is a web site where shopping assistant functionality may be available when the site is visited by a shopper (specification, page 51, lines 11-21).

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2. None of the cited references disclose or suggest code to determine if a web site is a supported merchant web site, as required by the claims

a. O'Leary et al.

The Office Action mailed August 10, 2005 states that O'Leary et al. fails to disclose determining if a merchant web site is a supported web site (page 6, last paragraph).

b. Sidles

The final Office Action mailed November 8, 2006 refers to a combined shopping system of O'Leary et al. and Sidles that includes "the determination code of Sidles" (page 3, last full paragraph). It is respectfully submitted that Sidles neither teaches nor suggests such determination code.

Sidles is concerned with an intelligent system for filling in merchant-supplied forms, including a dictionary database having rules for filling out unfamiliar forms (paragraph 62). The system of Sidles attempts to fill out forms from any merchant, even a merchant never previously visited (paragraph 35). Sidles teaches that ambiguities may arise in the use of the rules; such ambiguities need to be resolved by the system's fuzzy logic in the case of a newly-encountered form (paragraph 63). The use of a system with fuzzy logic, with rules for filling out forms from a merchant not previously encountered, indicates that Sidles is not concerned with whether a given merchant web site is a supported web site as recited in the claims.

The dictionary database of Sidles (paragraphs 61-64) includes rules for filling out forms and associations between addresses for certain forms and the applicable rules. The rules are associated with forms and fields within those forms (paragraph 62), as opposed to merchant sites. The list of associations in the database (paragraph 64) is essentially a list of shortcuts to be used when the form at the given address is encountered. The applicable rule (or even whether a form is associated with a rule) does not determine whether the site where that form appears is supported for on-line shopping.

The list of forms and associated rules in the database (Sidles, Figure 10) cannot be equated with a list of supported merchant sites. For example, two different merchant sites (one a supported site and one not) could easily have similar forms, so that forms with addresses of both sites would be listed in the Sidles database as associated with the same rules. Accessing the database would then provide guidance on how to fill out the forms, but would be of no use in

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determining which site is supported. It follows that Sidles does not disclose or suggest any way to distinguish supported web sites from other web sites. Indeed, if the system of Sidles included code to determine supported merchants, then the system could recognize and keep a record of the particular forms associated with those sites. The system then would "know" what the forms from a supported merchant looked like, and ignore forms from unsupported sites. There would then be no need for an intelligent system to interpret and fill out unfamiliar forms.

One following the teaching of Sidles would employ an expert system in combination with a system for on-line shopping to visit and interact with a randomly chosen merchant web site. The merchant site would presumably present a form, which the expert system would attempt to fill out. The site would, in general, not be known in advance, and thus would not be on any list maintained by the system (let alone a list of supported sites). The system would apply some rules related to the filling out of forms, but those rules could not evaluate any other features of the merchant site, particularly if the site had not been previously visited. The system of Sidles therefore clearly lacks determination code configured to determine if a merchant web site is a supported merchant web site, as required by the claims.

c. Wiens et al.

Wiens et al. likewise is concerned with connecting to a vendor computer, and is not concerned with whether a vendor is supported. In the on-line shopping environment of Wiens et al., the customer knows which vendor he intends to connect to, by virtue of having already completed much of the order entry tasks. Wiens et al. teaches a dedicated environment whereby a person desiring to order articles from a website downloads an order entry form from that website that can be completed while the user is off-line. The Wiens et al. reference, rather than teaching software code being downloaded and used for determining whether a website is a supported merchant website, teaches code that the shopper uses to fill out a form and then log into a known website to upload the form, with the intended purpose of saving bandwidth. One using the method of Wiens et al. would connect (typically using a dial-up system) to a vendor computer where the identity of the vendor is already known (Wiens et al., col. 5, lines 39-54). Once the connection to the vendor computer is made, the customer's order is placed without further inquiry to the vendor (Wiens et al., col. 5, lines 55-60). There is thus no need to

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determine, in the environment of Wiens et al., whether a merchant web site is supported as required by the claims.

Furthermore, with regard to Wiens et al., Wiens et al. (col. 7, lines 28-47, and Figure 2) discloses a process in which a vendor information file is downloaded to a user if the version stored at the user's computer is not the current version. This version control process is not related to, nor does it function as, a process for determining if a website is a supported merchant website, as claimed. Whether an updated order form file is downloaded or not has no effect on the on-line ordering process. Indeed, Wiens et al. states that the process of Figure 2 is preferably performed after the order is taken and confirmed (col. 7, lines 23-24). The outcome of this process, and whether the new version of the vendor information file is downloaded, essentially depends on how recently the user was last connected to the vendor computer. The vendor information file contains product information and/or advertising and is provided as a convenience for the user when the user composes a purchase order off-line (col. 6, line 66, to col. 7, line 4). Wiens et al. suggests (col. 7, lines 29-32) code for comparing the user's version of this file with the current version downloadable from the vendor computer. This version-checking code (essentially, code for checking the freshness of the product information or advertising) is not intended to determine any features or capabilities of the vendor computer when the user is connected thereto. Similarly, any vendor information file downloaded to the user computer is intended only to provide information to a customer for his off-line use, and has no function for determining any properties of the vendor computer, much less whether the website the user is connecting to is a supported merchant website. Indeed, no such determination is taught or suggested by Wiens et al since the merchant a user is in communication with, and the website from which the updated code will be sent, is already known.

Accordingly, it is respectfully submitted that Wiens et al. does not teach or suggest determination code to determine if a merchant web site is a supported merchant web site, as required by the claims.

3. A combination of the cited references fails to disclose or suggest code to determine if a web site is a supported merchant web site, as required by the claims

One skilled in the art would not have been led to combine systems for making on-line purchases and payments (O'Leary et al. and Sidles) with a method in which the purchase order is composed off-line (Wiens et al.). Nevertheless, a combination of O'Leary, Sidles and Wiens et al. would at best yield a system in which a customer would visit a merchant web site (O'Leary et al.) and be presented with a form to fill out, which would then be filled out by an expert system (Sidles). The customer would then prepare an order off-line (Wiens et al.) and then transmit order information to the merchant. By filling out a merchant-supplied form (where the information fields are interpreted according to rules in a system database, without regard to the merchant site), the user supplies information to the merchant site, but does not obtain information regarding any particular functionality available from a the site; the form-filling process does not involve determining whether a site is supported, as required by the claims.

Accordingly, the above-noted limitations recited in the claims, at least, are not rendered obvious by any of the cited references, or by a combination thereof.

4. None of the cited references disclose or suggest communicating code to determine if a web site is a supported merchant web site, as required by the claims

a. A two-way combination of O'Leary et al. and Sidles does not meet the claim limitations

The final Office Action mailed November 8, 2006 states that O'Leary et al. and Sidles both fail to teach communicating determination code to the user's computer for determining if a merchant site is a supported web site (Office Action, page 3, last full paragraph). Wiens et al. (col. 7, lines 28-47) is then relied upon in the Office Action for a teaching of communicating computer code to a user's computer from a remote vendor, the code containing "pertinent vendor information" (a term coined by the Examiner and not used in Wiens et al.).

b. Wiens et al. emphasizes composing orders off-line, in contrast to determining whether a merchant website is supported for on-line shopping

Wiens et al. teaches a system whereby a typical computer such as a personal computer has installed thereon custom software that enables the computer to communicate with a centrally located vendor computer to which a customer may connect via a customary communication medium, such as a modem through telephone lines, etc. (col. 4, lines 25-30). According to Wiens et al., this custom software facilitates off-line order entry so that a user may complete an automated order and only connect to the vendor's central computer to actually place the order after the order information has been entered off-line. The Wiens et al. system allows users to compose their orders prior to calling the central computer, thus minimizing telephone expenses (col. 3, lines 37-41). Wiens et al. thus teaches a dedicated environment whereby a person desiring to order articles from a website downloads an order entry form from that website, to be completed while the user is off-line. The Wiens et al. reference, rather than teaching software code being downloaded and used for determining whether a website is a supported merchant website, teaches code that the shopper uses to fill out a form and then log into a known website to upload the form, with the intended purpose of saving bandwidth.

Wiens et al. therefore teaches an environment where the user already knows the identity of the vendor it intends to communicate with. Indeed, a user of the Wiens et al. system completes much of the order entry task prior to establishing a communication session with the vendor computer. Thus in Wiens et al. no determination of whether a website is a supported website needs to be made.

c. Communicating vendor information in Wiens et al. is unrelated to determining whether a website is supported

It is clear from Wiens et al. that the information communicated to the customer is a current version of a vendor information file (col. 7, lines 41-47). Wiens et al. teaches communicating an updated version of the vendor information file to a user's computer if it is determined that the user's computer does not have the current version stored thereon (col. 6, lines 62-65). As noted above, a given version of a vendor information file is a static collection of product information and/or advertising. Determining the version of a file on the customer's

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computer merely determines the freshness of data previously offered by the vendor. As discussed in detail above, this determination is in no way related to determining whether a merchant website is supported for on-line shopping.

It should be noted that this communication between the vendor and the user's computer is to facilitate the off-line process prior to establishing an on-line ordering session. The user consults the vendor information file in order to avoid having to go on-line (col. 6, line 66, to col. 7, line 4). When the user does connect with the vendor computer, the identity of the vendor is already known; the user proceeds to place his order, without being concerned whether the vendor's website is a supported website. Accordingly, nothing in Wiens et al. in any way teaches or suggests communication of determination code to the user's computer for determining if a merchant website is a supported website; no such determination code is necessary. Communicating determination code, as recited in the claims, is not in any way equivalent to determining a current version of a vendor information file on a user's computer as taught by Wiens et al..

5. A combination of the cited references fails to disclose or suggest communicating code to determine if a web site is a supported merchant web site, as required by the claims

A combination of Sidles/O'Leary et al. with Wiens et al. would at best yield a system wherein a user visits a vendor website, is presented with forms to fill out, fills out those forms using an expert system, prepares an order offline, and then contacts that vendor to complete the order. Transmitting the order to the vendor might include identifying the current version of an information file on the user's computer, which can then be updated by a download from the vendor computer. This communication (as taught by Wiens et al. and even if applied to Sidles/O'Leary et al.) clearly does not involve communicating determination code, as required by the claims.

Wiens et al. does not and cannot supply the element admittedly missing from the Sidles/O'Leary combination of communicating determination code to the user's computer to determine whether a website is a supported merchant website. This is so because in the Wiens et al. system the user only communicates with specific known merchant sites. The system of Wiens et al. exists in an environment where no determination of a supported merchant needs to

be made. Accordingly, the above-noted limitations of the claims are not rendered obvious by a combination of Wiens et al. with Sidles and O'Leary et al.

6. A combination of Wiens et al. with O'Leary et al. and Sidles is improper

a. The cited art does not suggest the desirability of the combination

As noted above, Wiens et al. is concerned with composing an order off-line, and then connecting to a vendor computer of a preselected vendor to complete the order. O'Leary et al. and Sidles, by contrast, teach visiting a merchant website (which may or may not be previously known), filling out merchant-supplied forms during the on-line session, placing an order and making an on-line payment. O'Leary et al. and Sidles clearly envision the user having an on-line shopping experience using an Internet browser, where the user composes his order during an on-line session. The Sidles/O'Leary et al. combination clearly does not suggest preparing an order off-line, or otherwise limiting or avoiding on-line communication with a merchant website. There is therefore nothing in the Sidles/O'Leary et al. Internet-related combination suggesting that it would be desirable to make a three-way combination with a primarily offline system as taught in Wiens et al.

b. The combination of Wiens et al. with Sidles/O'Leary et al. teaches away from the limitations recited in the claims

The Office Action states that O'Leary et al. and Sidles both fail to explicitly teach communicating determination code to the user's computer for determining if a merchant website is a supported website. One skilled in the art would not look to Wiens et al. for a remedy, since Wiens et al. teaches a dedicated relationship between the user's computer, the software thereon, and the vendor's computer. Thus in the Wiens et al. system no determination of a supported merchant need be made since the user already knows which vendor it intends to connect to; the user enters his order information on his own computer prior to establishing a dedicated communication session with that vendor.

Furthermore, Wiens et al. teaches communicating information files from the merchant to the user's computer to inform the user regarding the merchant's goods and services, without the need for the user to go on-line. This feature of Wiens et al. thus discourages on-line browsing of

different merchant sites, and therefore does nothing to suggest that the O'Leary/Sidles combination should be modified to incorporate the determination of supported merchants being made at the user's computer.

Accordingly, it is respectfully submitted that a combination of Wiens et al. with O'Leary et al. and Sidles is improper, and that even in view of this combination, the above-noted limitations (at least) of the claims are not rendered obvious.

B. Group (2): Claims 12-14, 16-17, 21, 23 and 24

1. Limitations recited in the claims

a. Independent browser interface claim 12 recites a toolbar button defined by computer code, operable with a processor of the user's computer, for determining if a web site to which the Internet browser is caused to navigate is a supported merchant web site.

b. Independent claim 21 recites a method of facilitating on-line shopping by a shopper having a computer with an Internet browser; the method comprises the step of communicating computer code which determines at the shopper's computer if a web site to which the Internet browser is caused to navigate is a supported merchant web site.

c. Claims 13-14 and 16-17 depend from claim 12; claims 21, 23 and 24 depend from claim 21. All of these claims therefore include the limitations noted above.

2. None of the cited references disclose or suggest code determining at the user's (shopper's) computer if a web site is a supported merchant web site, as required by the claims

a. A two-way combination of O'Leary et al. and Sidles does not meet the claim limitations

The final Office Action mailed November 8, 2006 states that O'Leary et al. and Sidles both fail to teach the determination of a supported merchant web site being done at the user's computer (Office Action, page 10, last full paragraph). Wiens et al. (col. 7, lines 28-47) is then relied upon in the Office Action for a teaching of communicating computer code to a user's computer from a remote vendor, the code containing "pertinent vendor information."

b. Wiens et al. does not remedy the admitted defect in Sidles/O'Leary et al.

As discussed above, it is clear from Wiens et al. that the information communicated to the customer is a current version of a vendor information file (col. 7, lines 41-47). This file is provided to the user to facilitate the off-line process prior to establishing an on-line ordering session. The user consults the vendor information file in order to avoid having to go on-line (col. 6, line 66, to col. 7, line 4). When the user does connect with the vendor computer, the identity of the vendor is already known; the user proceeds to place his order without being concerned whether the vendor's website is a supported website. Wiens et al. thus does not teach or suggest any need for a determination of whether a website is supported or not. Furthermore, the vendor information communicated to the user (that is, an updated information file) is not intended to be processed as code for determining any properties of the vendor computer   Accordingly, nothing in Wiens et al. contemplates determining at the user's computer if a merchant website is a supported website, as required by the claims.

3. A combination of the cited references fails to disclose or suggest determining at the user's computer if a web site is a supported merchant web site, as required by the claims

As discussed in detail above, a combination of Sidles/O'Leary et al. with Wiens et al. would at best yield a system in which a user consults a vendor information file at the user's computer while preparing an order off-line. Transmitting the order to the vendor may include identifying the current version of the information file on the user's computer, which can then be updated by a download from the vendor computer. The vendor information file at the user's computer (as taught by Wiens et al. and even if applied to Sidles/O'Leary et al.) clearly does not relate to determining if a web site is a supported merchant web site, as required by the claims.

Wiens et al. does not and cannot supply the element admittedly missing from the Sidles/O'Leary combination of determining at the user's computer whether a website is a supported merchant website. This is so because in the Wiens et al. system the user only communicates with specific known merchant sites. The system of Wiens et al. exists in an environment where no determination of a supported merchant needs to be made. Accordingly,

the above-noted limitations of the claims are not rendered obvious by a combination of Wiens et al. with Sidles and O'Leary et al.

4. A combination of Wiens et al. with O'Leary et al. and Sidles is improper

As discussed in detail above, there is nothing in the Sidles/O'Leary et al. Internet-related combination suggesting that it would be desirable to make a three-way combination with a primarily offline system as taught in Wiens et al. Furthermore, as discussed above, in the Wiens et al. system no determination of a supported merchant need be made since the user already knows which vendor it intends to connect to; there is thus clearly no determining at the user's computer whether a merchant website is a supported website. It is therefore respectfully submitted that the combination of Wiens et al. with Sidles/O'Leary et al. teaches away from the limitations recited in the claims, and that a combination of Wiens et al. with O'Leary et al. and Sidles is improper; even in view of this combination, the above-noted limitations (at least) of the claims are not rendered obvious.

C. Group (3): Claim 60

1. Limitations recited in the claim

Independent claim 60 recites a method of facilitating on-line shopping by a shopper having a computer with an Internet browser. The method comprises the step of determining at the shopper's computer if a web site to which the Internet browser is caused to navigate is a supported merchant web site; a shopping assistant button on a toolbar of the browser provides an indicator when the Internet browser is caused to navigate to a supported merchant web site.

2. None of the cited references disclose or suggest code determining at the shopper's computer if a web site is a supported merchant web site, as required by the claims

Claim 60 recites a step of determining at the shopper's computer if a web site to which the Internet browser is caused to navigate is a supported merchant web site; this claim language is similar to that of claim 21. The final Office Action mailed November 8, 2006 states that

O'Leary et al. and Sidles both fail to teach the determination of a supported merchant web site being done at the user's computer (Office Action, page 10, last full paragraph). Wiens et al. (col. 7, lines 28-47) is relied upon in the Office Action for a teaching of communicating computer code to a user's computer from a remote vendor, the code containing "pertinent vendor information." It is submitted that Wiens et al. does not remedy the admitted defect in Sidles/O'Leary et al. with respect to this claim limitation, for the same reasons as detailed above.

3. A combination of the cited references fails to disclose or suggest determining at the user's computer if a web site is a supported merchant web site, as required by the claims

As discussed in detail above, a combination of Sidles/O'Leary et al. with Wiens et al. does not render the claim obvious, since Wiens et al. does not and cannot supply the element admittedly missing from the Sidles/O'Leary combination of determining at the user's computer whether a website is a supported merchant website.

4. None of the references, nor a combination thereof, teaches or suggests that a toolbar button provides an indicator when the Internet browser is caused to navigate to a supported merchant web site, as required by the claim

As noted above, O'Leary et al. does not teach determining if a merchant web site is a supported web site (final Office Action mailed November 8, 2006, page 6, last paragraph). It follows that O'Leary et al. cannot and does not teach an indicator when the browser is caused to navigate to a supported web site. O'Leary et al. describes a wallet function (paragraph 52) launched by the user, which may be accessed through a toolbar button or an icon. O'Leary et al. states that the wallet may be accessed by selecting an icon at a merchant's web site. Since the wallet functionality is not derived from the merchant web site, the appearance of a wallet icon does not indicate whether the merchant web site is a supported web site as required by the claims. O'Leary et al. simply states that the icon may be selected, without regard to whether the merchant web site is supported. No icon in any of the cited references is disclosed to act as an indicator that a user has navigated to a supported merchant website, as recited in the subject claim.

Sidles is not understood to teach or suggest determining if a merchant web site is a supported web site. Furthermore, Sidles does not teach or suggest a toolbar button, let alone a button provided with an indicator as recited in the claim. Wiens et al. likewise does not teach or suggest either a toolbar button or an indicator. Sidles and Wiens et al. therefore do not remedy the deficiency of O'Leary et al. with regard to an indicator of a toolbar button as recited in the claims.

III. Arguments with respect to ground of rejection (2)

A. Claims 15 and 22

1. Limitations recited in the claims

a. Claim 15 depends from independent Internet browser interface claim 12, and therefore includes the limitation of a toolbar button defined by computer code, operable with a processor of the user's computer, for determining if a web site to which the Internet browser is caused to navigate is a supported merchant web site. Claim 15 further recites that the computer code is operable with the processor for adding a toolbar and the shopping assistant button.

b. Claim 22 depends from independent method claim 21 directed to a method of facilitating on-line shopping by a shopper having a computer with an Internet browser; claim 22 therefore includes the limitation of communicating computer code which determines at the shopper's computer if a web site to which the Internet browser is caused to navigate is a supported merchant web site. Claim 22 further recites a step of communicating computer code to add a shopping assistant button and a toolbar of the Internet browser.

2. None of the cited references disclose or suggest code determining at the shopper's computer if a web site is a supported merchant web site, as required by the claims

The final Office Action mailed November 8, 2006 states that O'Leary et al. and Sidles both fail to teach the determination of a supported merchant web site being done at the user's computer (Office Action, page 10, last full paragraph). Wiens et al. (col. 7, lines 28-47) is relied upon in the Office Action for a teaching of communicating computer code to a user's computer

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from a remote vendor, the code containing "pertinent vendor information." It is submitted that Wiens et al. does not remedy the admitted defect in Sidles/O'Leary et al. with respect to this claim limitation, for the same reasons as detailed above.

"Band Objects" is limited to a discussion of objects displayed in a taskbar, on a desktop, or in a browser window. This reference does not include any information relating to on-line shopping or determining if a web site is a supported website. Accordingly, the "Band Objects" reference does not and cannot remedy the above-noted deficiencies of O'Leary et al., Sidles and Wiens et al.

3. A combination of the cited references fails to disclose or suggest determining at the user's computer if a web site is a supported merchant web site, as required by the claims

As discussed in detail above, a combination of Sidles/O'Leary et al. with Wiens et al. does not render the claim obvious, since Wiens et al. does not and cannot supply the element admittedly missing from the Sidles/O'Leary combination of determining at the user's computer whether a website is a supported merchant website. Similarly, a combination of those three references with "Band Objects" cannot supply the missing element.

IV. Conclusion

It is respectfully submitted that a *prima facie* case of obviousness has not been established for any of the rejected claims. All of claims 1-24, 59 and 60 are therefore believed to be in condition for allowance.

37 C.F.R. § 41.37(c)(1)(viii): CLAIMS APPENDIX

An appendix containing a copy of the claims involved in this appeal is attached hereto.

37 C.F.R. § 41.37(c)(1)(ix): EVIDENCE APPENDIX

None (no evidence has been submitted in this application pursuant to 37 C.F.R. §§ 1.130, 1.131, or 1.132).

37 C.F.R. § 41.37(c)(1)(x): RELATED PROCEEDINGS APPENDIX

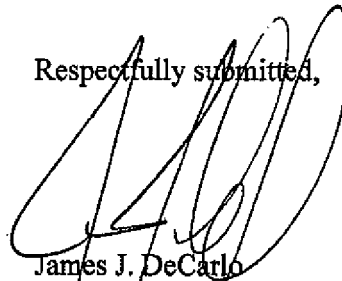None (there are no related appeals or interferences, and hence no decisions have been rendered).

The applicants' undersigned attorney may be reached by telephone at 212-801-6729. All correspondence should continue to be directed to the address listed below, which is the address associated with Customer Number 32361.

Respectfully submitted,

Date: __8/8/07__

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CLAIMS APPENDIX

1. A method of facilitating on-line shopping by a shopper at a supported merchant web site, the shopper having a computer with an Internet browser installed thereon, said method comprising the steps of:

    (a)   communicating computer code to add a shopping assistant button to a toolbar of the Internet browser;

    (b)   communicating determination computer code to the computer, the determination computer code configured to determine if a merchant web site is a supported merchant web site;

    (c)   creating a wallet for the shopper in a database on a server, the wallet being secured by a first security key previously received from the shopper;

    (d)   receiving a second security key from the shopper;

    (e)   comparing the first security key and the second security key; and

    (f)   if the first and second security keys are the same, communicating the wallet to the computer.

2. A method as recited by claim 1, further comprising the step of providing a supported merchant rules and mapping file for the supported merchant, and wherein said step (a) further comprises communicating computer code for automatically filling out a check-out web page of the supported merchant web site using the wallet and the supported merchant rules and mapping file.

3. A method as recited by claim 1, wherein the shopping assistant button comprises a pull-down menu.

4. A method as recited by claim 1, wherein said step (b) comprises:
    communicating a web page for display by the Internet browser;
    receiving shopper data entered by the shopper in the web page; and
    storing at least a portion of the shopper data as a wallet for the shopper in the database.

5. A method as recited by claim 1, wherein said step (a) further comprises communicating computer code to monitor the Internet navigation of the Internet browser by intercepting an Internet address for each Internet site to which the Internet browser is caused to navigate.

6. A method as recited by claim 5, further comprising the step of providing a supported merchant rules and mapping file for the supported merchant, and wherein said step (a) further comprises communicating computer code for automatically filling out a check-out web page of the supported merchant web site using the wallet and supported merchant rules and mapping file.

7. A method as recited by claim 1, further comprising the step of communicating a supported merchant data file.

8. A method as recited by claim 7, wherein said step (a) further comprises determining if a merchant web site is a supported merchant web site by comparing the supported merchant data file with an Internet address for each Internet site to which the Internet browser is caused to navigate.

9. A method as recited by claim 7, wherein the computer code provides an indicator for the shopping assistant button when the Internet browser is at a supported merchant web site.

10. A method as recited by claim 1, wherein said step (a) further comprises communicating computer code for intercepting each web page received by the browser and determining the type of web page by HTML code and http response headers provided in the intercepted web page.

11. A method as recited by claim 1, wherein said step (e) comprises communicating a secure cookie to the computer.

12. An Internet browser interface displayable by an Internet browser on a computer display comprising:

    a toolbar; and

a shopping assistant button in said toolbar and defined by computer code received from a content provider operable with a processor of the computer for:

intercepting an Internet address for each Internet site to which the Internet browser is caused to navigate;

determining if a web site to which the Internet browser is caused to navigate is a supported merchant web site; and

if the web site is a supported merchant web site, automatically filling out a check-out web page of the supported merchant web site using a wallet and a supported merchant rules and mapping file.

13. An Internet browser interface as recited by claim 12, wherein said determining step comprises determining if a web site to which the Internet browser is caused to navigate is a supported merchant web site by comparing a supported merchant data file with an Internet address for each Internet site to which the Internet browser is caused to navigate.

14. An Internet browser interface as recited by claim 12, wherein said shopping assistant button comprises a pull-down menu.

15. An Internet browser interface as recited by claim 12, wherein the computer code is further operable with the processor for adding a toolbar and the shopping assistant button to said Internet browser interface.

16. An Internet browser interface as recited by claim 12, wherein said shopping assistant button provides an indicator when the Internet browser is caused to navigate to a supported merchant web site.

17. An Internet browser interface as recited by claim 12, wherein the computer code is further operable with the processor for intercepting each web page received by the browser and determining the type of web page by HTML code and http response headers provided in the intercepted web page.

18. A system for facilitating on-line shopping by a shopper having a computer with an Internet browser, said system comprising:

a server comprising:

a data storage device having a database thereon; and

a processor operable with software for:

communicating shopping assistant computer code to add a shopping assistant button to a toolbar of the Internet browser, the shopping assistant computer code operable to determine if a web site to which the Internet browser is caused to navigate is a supported merchant web site;

receiving wallet data including a first security key from the shopper and creating a wallet for the shopper in the database, the wallet being secured by the first security key;

receiving a second security key from the shopper;

comparing the first security key and the second security key; and

if the first and second security keys are the same, communicating the wallet to the computer.

19. A system as recited by claim 18, wherein said server is a secure server.

20. A system as recited by claim 18, wherein said processor is further operable with software for providing a supported merchant rules and mapping file when the shopper has caused the Internet browser to navigate to a supported merchant web site, and wherein the shopping assistant code for automatically fills out a check-out web page of the supported merchant web site using the wallet and supported merchant rules and mapping file.

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21. A method of facilitating on-line shopping by a shopper at a supported merchant web site, the shopper having a computer with an Internet browser installed thereon, said method comprising the step of communicating computer code to add a shopping assistant button to the Internet browser, wherein said computer code intercepts an Internet address for each Internet site to which the Internet browser is caused to navigate, determines at the computer if a web site to which the Internet browser is caused to navigate is a supported merchant web site, and if the web site is a supported merchant web site, automatically fills out a check-out web page of a supported merchant web site using a wallet and a supported merchant rules and mapping file.

22. A method as recited by claim 21, wherein said communicating step further comprises communicating computer code to add a shopping assistant button and a toolbar of the Internet browser.

23. A method as recited by claim 21, wherein said shopping assistant button further provides an indicator when the Internet browser is caused to navigate to a supported merchant web site.

24. A method as recited by claim 21, wherein said computer code determines if a web site to which the Internet browser is caused to navigate is a supported merchant web site by comparing a supported merchant data file with an Internet address for each Internet site to which the Internet browser is caused to navigate.

59. A method as recited by claim 7, wherein the merchant data file comprises supported merchant rules and mapping information.

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60. A method of facilitating on-line shopping by a shopper at a supported merchant web site, the shopper having a computer with an Internet browser installed thereon, said method comprising the steps of:

(a)   communicating computer code to add a shopping assistant button to a toolbar of the Internet browser;

(b)   creating a wallet for the shopper in a database on a server, the wallet being secured by a first security key previously received from the shopper;

(c)   determining at the computer if a web site to which the Internet browser is caused to navigate is a supported merchant web site, and wherein said shopping assistant button further provides an indicator when the Internet browser is caused to navigate to a supported merchant web site;

(d)   receiving a second security key from the shopper;

(e)   comparing the first security key and the second security key; and

(f)   if the first and second security keys are the same, communicating the wallet to the computer.

EVIDENCE APPENDIX:

None

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RELATED PROCEEDINGS APPENDIX:

None

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